UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,996	05/11/2006	Carsten Herpel	PD030116	5098

24498   7590   07/14/2011
Robert D. Shedd, Patent Operations
THOMSON Licensing LLC
P.O. Box 5312
Princeton, NJ 08543-5312

EXAMINER
VU, THANH T

ART UNIT	PAPER NUMBER
2175	

MAIL DATE	DELIVERY MODE
07/14/2011	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	**Applicant(s)**
Office Action Summary	10/578,996	HERPEL ET AL.
	Examiner	**Art Unit**	
	THANH VU	2175	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 April 2011*.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14 and 16-21* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14 and 16-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application

6)☐ Other: _____ .

DETAILED ACTION

This communication is responsive to Amendment, filed 04/26/2011.

Claims 1-14 and 16 are pending in this application. In the Amendment, claim 15 have

been cancelled, claims 17-21 have been added, and claims 1, 3, 10, 11 and 14 have been

amended. This action is made Final.

Claim Objections

Claims 19 and 21 are objected to because of the following informalities: the claims recite

the term AV. The examiner assumes AV stands for "audio-visual" with respect to applicant's

independent claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the
> subject matter which the applicant regards as his invention.

Claims 21 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for

failing to particularly point out and distinctly claim the subject matter which applicant regards as

the invention.

Claim 21 recites the limitation "the at least one command". There is insufficient

antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1-14, 16-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dinallo et al. (US 5,929,857) and Collart et al. ("Collart", Pub. No. 2006/0181965).

Per claim 1, Dinallo teaches a method for automatically composing an electronic audio-visual menu for selection of playback of audio-visual data, wherein a first portion of audio-visual data and a first portion of menu data are retrieved from a first storage medium being an exchangeable pre-recorded medium, and wherein a second portion of audio-visual data and a second portion of menu data are obtained from a second data source (fig. 1), wherein said second portion of menu data has at least one attribute associated, the method comprising the steps of:

generating an initial menu from the first portion of menu data, the initial menu containing one or more visible, selectable buttons and at least one invisible placeholder that cannot be selected, wherein the placeholder has at least one attribute associated (col. 9, lines 1-12 and 35-42, col. 10, lines 30-42);

extracting said attribute associated with the second portion of menu data (col. 7, lines 22-25 and lines 53-58; col. 9, lines 1-12);

comparing said extracted attribute with said attribute associated with the placeholder; and based on said comparison, if both attributes match, replacing the placeholder with a visible and selectable button defined by the second portion of menu data (col. 7, lines 40-45 and lines 54-60; col. 9, lines 44-51; col. 10, lines 31-42).

Dinallo does not specifically teach wherein the second data source is different form said first storage medium, wherein said second portion of audio-visual comprises no menu data and wherein said second portion of menu data comprises audio-visual menu data." However, Collart teaches wherein the second data source is different form said first storage medium, wherein said

second portion of audio-visual comprises no menu data and wherein said second portion of menu

data comprises audio-visual menu data (figs. 3; [0007]; [0044]; [0049]-[0051].) Therefore, it

would have been obvious to one of ordinary skill in the art at the time of the invention to include

the teaching of Collart in the invention of Dinnallo in order to provide the user with latest video

content related a DVD storage medium.

Per claim 2, the modified Dinallo teaches method according to claim 1, further

comprising the step of automatically detecting the availability of said second portion of menu

data or of said second portion of audio-visual data (Dinallo, col. 7, lines 20-37; col. 10, lines 30-

42).

Claim 3 is rejected under the same rationale as claim 1.

Per claim 4, the modified Dinallo teaches method or device according to claim 1, wherein

the second data source is a local storage medium, and the data that defines the visible and

selectable menu button replacing the placeholder contains a unique reference to the stored

second portion of audio-visual data (Dinallo, fig. 1; storage medium 200 and 210).

Per claim 5, the modified Dinallo teaches method or device according to claim 1, wherein

the data that defines the visible and selectable button replacing the placeholder further contains

button location information or a specification of conditions for button activation (Dinallo, col. 8,

lines 18-41).

Per claim 6, the modified Dinallo teaches method or device according to claim 1, wherein

the data that defines the visible and selectable button replacing the placeholder further contains

picture data defining the appearance of the button (Dinallo, col. 9, lines 40-51; col. 10, lines 30-

42).

Per claim 7, the modified Dinallo teaches method or device according to claim 1, wherein

the exchangeable storage medium is rewritable, and said second portion of audio-visual data and

said second portion of menu data are also stored on said medium (Dinallo, fig. 1; storage

medium 200 and 210).

Per claim 8, the modified Dinallo teaches method or device according to claim 1, wherein

upon replacement of one or more placeholders by one or more visible and selectable buttons

another, previously visible and selectable button defined in the first portion of menu data is

disabled and switched invisible (Dinallo, col. 8, lines 29-31, lines 55-56; col. 9, lines 1-12 and

lines 44-51).

Per claim 9, the modified Dinallo teaches method or device according to claim 1, wherein

said second portion of menu data contains navigation chaining information (Dinallo, col. 9, lines

44-52).

Claim 10 is rejected under the same rationale as claim 1.

Per claim 11, the modified Dinallo teaches device according to claim 3, wherein the

second data source is a local storage medium, and the data that defines the visible and selectable

menu button replacing the placeholder contains a unique reference to the stored second portion

of audio-visual data (Dinallo, *fig. 2 shows a second data source 210*; *fig. 5 and col. 60-67; which

states of menu buttons*).

Per claim 12, the modified Dinallo teaches device according to claim 3, wherein the data

that defines the visible and selectable button replacing the placeholder further contains button

location information or a specification of conditions for button activation (Dinallo, *fig. 5 and

col. 60-67; which states of menu buttons*).

Per claim 13, the modified Dinallo teaches device according to claim 3, wherein the data that defines the visible and selectable button replacing the placeholder further contains picture data defining the appearance of the button (Dinallo, fig. 5 and col. 9, lines 1-12 and 60-67 and col. 10, lines 30-35; *which shows states of menu buttons having set of bitmaps*).

Per claim 14, the modified Dinallo teaches Device according to claim 3, wherein the exchangeable storage medium is rewritable, and said second portion of audio-visual data and said second portion of menu data are also stored on said medium (Dinallo, fig. 1 shows exchangeable storage medium 142, 147 and 152; fig. 2 shows audio visual data menu are stored on medium 210).

Per claim 15, the modified Dinallo teaches device according to claim 3, wherein upon replacement of one or more placeholders by one or more visible and selectable buttons another, previously visible and selectable button defined in the first portion of menu data is disabled and switched invisible (Dinallo, col. 8, lines 29-31 and lines 50-54, *which shows states of buttons and scroll off screen of menu*).

Per claim 16, the modified Dinallo teaches device according to claim 3, wherein said second portion of menu data contains navigation chaining information (Dinallo, col. 10, lines 44-52).

Claims 17 and 20, the modified Dinallo teaches wherein the at least one invisible placeholder remains invisible if both attributes fail to match, based on said comparison (Dinallo, Dinallo, col. 8, lines 29-31 and lines 50-54; Collart, figs. 3; [0007]; [0029]; [0030]; [0044]; [0049]-[0051].)

Claim 18, the modified Dianallo teaches method according to claim 1, wherein the data

replacing the at least one invisible place holder that is retrieved from the second data source

comprises at least one command (Collart, figs. 3; [0007]; [0044]; [0049]-[0051].)

Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Dinallo et al. (US 5,929,857), Collart et al. ("Collart", Pub. No. 2006/0181965) and

Raciborski (US 2006/0031785).

Claim 19 and 21, the modified Dinallo does not specifically teach wherein the at least one

command is a playback command for playing AV content from a location which that is other

than the first storage medium. However, Raciborski teaches at least one command is a playback

command for playing AV content from a location which that is other than the first storage

medium (fig. 2A; [0040].) Therefore, it would have been obvious to one of ordinary skill in the

art at the time of the invention to include the teaching of Raciborski in the invention of the

modified Dinnallo in order to provide the user with additinal video content related a DVD

storage medium.

Response to Arguments

Applicants' arguments in the Amendment have been fully considered but are not

persuasive.

Applicants' primary argument is that Dinallo does not teach the limitations of "wherein

the second data source is different form said first storage medium, wherein said second portion

of audio-visual comprises no menu data and wherein said second portion of menu data comprises

audio-visual menu data." In response to applicant's arguments against the references

individually, one cannot show nonobviousness by attacking references individually where the

rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In this case, Collart teaches wherein the second data source is different form said first

storage medium, wherein said second portion of audio-visual comprises no menu data and

wherein said second portion of menu data comprises audio-visual menu data (figs. 3; [0007];

[0044]; [0049]-[0051].)

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this

Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this

final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to THANH VU whose telephone number is (571)272-4073. The

examiner can normally be reached on Mon- Fri 7:00AM - 3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, William L. Bashore can be reached on (571) 272-4088. The fax phone number for

the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thanh T. Vu/
Primary Examiner, Art Unit 2175